

### REMARKS

In the Restriction Requirement mailed January 5, 2007, the Examiner has asserted restricting the claims to one of the following inventions under 35 U.S.C. 121:

- I. Claims 1-58, drawn to a fiducial marker, classified in class 600, subclass 414.
- II. Claims 59-70, drawn to a method for driving a marker into a bone, classified in class 606, subclass 104.

(Restriction Requirement at 2.)

In response, Applicant provisionally elects, *with traverse*, to prosecute Group I, identified in the Restriction Requirement as claims 1-58. In view of the traversal, Applicant respectfully declines to cancel the non-elected claims. However, if such non-elected claims are withdrawn by the Examiner in spite of the present traversal, Applicant respectfully reserves the right to later re-introduce such claims in this or in one or more divisional or continuation patent applications. No claims have been added. As a result, claims 1-70 remain pending in this patent application.

### Grounds For Traversal

The Restriction Requirement asserts:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced by another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case Invention II does not require the particulars of Invention I in order to use the guide collar. Invention I could be driven into a patient's bone using a different method.

(Restriction Requirement at 2.) First, Applicant respectfully notes that the scope of the independent method claim 59 substantially commensurate with the scope of at least independent apparatus claim 1, such that there is no undue burden with examining Groups I and II together. Moreover, the Restriction Requirement is unsupported by its assertion that "Invention II does not require the particulars of Invention I in order to use the guide collar." Applicant respectfully submits that this statement is immaterial as a basis of restriction. Although the guide collar is

used in certain examples, it is not required for either Invention I or II. (*See* Application at page 29, line 33 – page 32, line 7; and Figs 31-34.) Accordingly, the use of a guide collar not even recited in independent method claim 59 or either independent apparatus claim 1 or 32, but instead is merely recited in dependent claims 67-70.

The Restriction Requirement also asserts that “Invention I could be driven into a patient’s bone using a different method.” To the extent that the Restriction Requirement is referring to use of something other than the guide collar when referring to a “different method,” Applicant reiterates that the use of a guide collar is not required in the method recited in claim 59. Claim 59 recites, in part, “driving directly into a bone of a patient a fiducial marker device” without any mention of a guide collar. Therefore, claim 59 allows for different methods with which “Invention I could be driven into a patient’s bone.” Thus, Applicant respectfully submits that there is presently no objective evidence of record supporting the present improper restriction.

Furthermore, Applicant respectfully submits that the Restriction Requirement has arbitrarily and capriciously classified Group I into class 600, subclass 414 (defined as “Subject matter including a reference or indicator on or in a body (e.g., target)”) and Group II into class 606, subclass 104 (defined as “Subject matter wherein means is provided for inserting or extracting an elongated element having helical threads or a thin elongated element having a nail like shape”). Applicant respectfully submits that Group II could just as easily have been classified into class 600, subclass 414 as Group I, or that Group I could just as easily have been classified into class 606, subclass 104 as Group II. In sum, the asserted arbitrary classifications of Groups I and II appear inappropriate.

Additionally, it is not understood why the previous Restriction Requirement, dated September 12, 2006, deemed it appropriate to classify claims 1-70 into class 600, subclass 426, and yet the current Restriction Requirement deems it necessary to classify Groups I and II differently, as stated above. Therefore, Applicant respectfully traverses the Restriction Requirement’s assertion that “the inventions have acquired a separate status in the art in view of their different classification” as being unsupported by any objective evidence of record.

Lastly, Applicant respectfully submits that the Restriction Requirement has not provided any objective evidence of record that there would be a “serious burden” on the Examiner if

restriction is not required.

In sum, Applicant respectfully requests withdrawal of the Restriction Requirement and coherent expedient examination of the claims of Group II together with the claims of provisionally elected Group I.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6951 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

MATTHEW S. SOLAR ET AL.

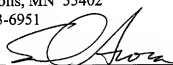
By their Representatives,

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Date

January 30, 2007

By



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**CERTIFICATE UNDER 37 CFR 1.8.** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 30<sup>th</sup> day of January 2007.

PATRICIA A. HULTMAN

Name

Signature

